

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Brian J. Petryna

Serial No.: 09/940,783

Filed: August 28, 2001

Title: SYSTEM AND METHOD FOR AUTOMATICALLY ESTABLISHING
A TELEPHONE CALL OVER A COMPUTER NETWORK

Grp./A.U.: 2476

Examiner: Andrew Chung Cheung Lee

Confirmation No.: 3916

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop Appeal Brief-Patents



ATTENTION: Board of Patent Appeals and Interferences

Sirs:

REINSTATEMENT OF APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This is an appeal from a non-final Office Action electronically delivered October 15, 2010 (hereinafter "Office Action"), of Claims 1-21. As directed on page 2 of the Office Action, the Appellant initiates a new appeal with the Notice of Appeal of April 22, 2010 and hereby submits this Brief applying the previously paid statutory Appeal Brief fee of \$540.00 set forth in 37 C.F.R.

§41.20(b)(2) of October 23, 2009. The Appellant hereby authorizes the Commissioner to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 08-2395.

This Brief contains these items under the following headings, and in the order set forth below, in accordance with 37 C.F.R. §41.37(c)(1):

- i) REAL PARTY IN INTEREST
- ii) RELATED APPEALS AND INTERFERENCES
- iii) STATUS OF CLAIMS
- iv) STATUS OF AMENDMENTS
- v) SUMMARY OF CLAIMED SUBJECT MATTER
- vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- vii) APPELLANTS' ARGUMENTS
- viii) APPENDIX A – CLAIMS
- ix) APPENDIX B – EVIDENCE
- x) RELATED PROCEEDINGS APPENDIX

i) REAL PARTY IN INTEREST

The real party in interest in this appeal is Agere Systems Inc.

ii) RELATED APPEALS AND INTERFERENCES

Appellant does not know of any prior and pending Appeals, Interferences, or Judicial Proceedings directly related to, affecting, affected by, or have a bearing on the Board's decision in this appeal.

iii) STATUS OF THE CLAIMS

Claims 1-21 are rejected.

Herein, all rejections of Claims 1-21 are being appealed.

iv) STATUS OF THE AMENDMENTS

No amendments have been made in response to the Office Action and no amendments are pending.

v) SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1 relates a system for automatically initiating a subsequent telephone call over a computer network 160 from a second caller to a first caller. The system comprises an address interceptor 140 and a network call initiator for the second caller. The address interceptor 140 is associated with a circuit-switched telephone network 120 and receives calling number identification signals of the first caller from a first telephone call from the first caller to the second caller over the circuit-switched telephone network 120. The address interceptor 140 extracts from the received

calling number identification signals a destination address of a computer system 130 of the first caller for the subsequent telephone call from the second caller's computer system 150 back to the first caller. The network call initiator is coupled to the address interceptor 140. The network call initiator employs the destination address of the first caller's computer system 130 to automatically initiate the subsequent telephone call to the destination address of the first caller via the second caller's computer system 150 over the computer network 160. As exemplified in Fig. 1, telephone station 110 and computer system 130 belong to a first caller and computer system 150 belongs to a second caller. A first call is placed from the first caller's telephone station 110 to an address interceptor 140 and the second caller's computer system 150 where, as noted above, the address interceptor 140 extracts a destination address of the first caller's computer system 130 from calling number identification signals sent with the first call. Then, a network call initiator employs the destination address of the first caller's computer system to automatically initiate a subsequent call from the second caller's computer system 150 to first caller's computer system 130 over computer network 160. (See, e.g., line 2 of page 8 through line 4 of page 10 and Fig. 1 of the original specification.)

Independent Claim 8 relates to a method of automatically initiating a subsequent telephone call over a computer network from a second caller to a first caller. The method comprises extracting a destination address of the first caller 430 and automatically initiating the subsequent telephone call 450 employing the destination address using a computer network to which both the first caller and second caller are connected to. The method extracts the destination address of the first caller from calling number identification signals received 410 from a first telephone call from the first caller to the second caller over a circuit-switched telephone network. Once the second caller has received the calling number identification signals from the first caller it then extracts the destination address of

the first caller from the received calling number identification signals. (*See, e.g.*, line 6 of page 13 through line 17 of page 14 and Fig. 4 of the original specification.)

Independent Claim 15 relates to a computer 210 which includes a processor 212; a memory 213, display 220, and at least one input 222/224 coupled to the processor; a circuit-switched telephone network interface 214 coupled to the processor 212; a computer network interface 216 coupled to the processor 212; an address interceptor 215 coupled to the processor 212 and circuit-switched telephone network interface 214; and a network call initiator 217 coupled to the processor 212. The circuit-switched telephone network interface 214 receives a first telephone call from a first caller over circuit-switched telephone network 230 that is coupled to the circuit-switched telephone network interface 214. The first telephone call includes calling number identification signals of the first caller. Address interceptor 215 extracts a destination address of the first caller from the calling number identification signals received by the circuit-switched telephone network interface 214. Network call initiator 216 uses the extracted destination address of the first caller and automatically initiates a subsequent telephone call to the first caller via computer network 240 to which the computer network interface 216 is coupled. (*See, e.g.*, line 5 of page 10 through line 19 of page 11 and Fig. 2 of the original specification.)

vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(A) Whether Claim 1 complies with the written description requirement of 35 U.S.C. §112, first paragraph.

(B) Whether Claim 8 complies with the written description requirement of 35 U.S.C. §112, first paragraph.

(C) Whether Claim 15 complies with the written description requirement of 35 U.S.C. §112, first paragraph.

(D) Whether Claims 2-7, 9-14, and 16-21 comply with the written description requirement of 35 U.S.C. §112, first paragraph.

(E) Whether Claim 1 complies with the requirements of 35 U.S.C. §112, second paragraph.

(F) Whether Claim 8 complies with the requirements of 35 U.S.C. §112, second paragraph.

(G) Whether Claim 1 is obvious over the combination of U.S. Patent No. 6,760,324 to Scott, *et al.* (hereinafter “Scott”) and U.S. Patent No. 6,192,045 to Williams, *et al.* (hereinafter “Williams”) as applied in the Office Action at pages 5-7.

(H) Whether Claim 8 is obvious over the combination of Scott and Williams as applied in the Office Action at pages 5-7.

(I) Whether Claim 15 is obvious over the combination of Scott and Williams as applied in the Office Action at pages 5-7.

(J) Whether Claims 2-7, 9-14, and 16-21 are obvious over the combination of Scott and Williams as applied in the Office Action at pages 7-9.

vii) APPELLANTS' ARGUMENT

(A) In Grounds of Rejection (A), the written description rejection of Claim 1 is improper because the limitations of Claim 1 which the Examiner alleges were not described in the original specification were described as noted below.

At Item 2 at the middle of page 3 in the Office Action, the Examiner alleges that neither a first caller nor second caller, as recited in pending independent Claim 1 “are not

disclosed and were not described in the specification at the time the application was originally filed.” The application as originally filed describes a system where a telephone call can automatically be initiated over a computer network. (*See, e.g.*, lines 5-14 on page 8 of the original specification.) For a telephone call to be completed, as the original specification discloses, one of ordinary skill in the art at the time of the invention would understand that the automatically initiated call must be between two callers. Pending independent Claim 1 recites one of those callers as a “first caller” and the other caller as a “second caller.” These callers could have been described as “caller A” and “caller B”. The descriptors of the callers are not relevant as the original specification discloses an automatically generated call is initiated.

The first paragraph of 35 U.S.C. §112 states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The first paragraph of 35 U.S.C. §112 requires that the specification shall contain a written description of the invention in terms as to enable any person skilled in the art to make and use the invention. Since the original specification, as noted above, describes an automatically initiated call, a person skilled in the art would understand that the call would be between a first caller and a second caller and, as such, the written description of an automatically initiated call in the original specification would enable the person skilled in the art to make and use the invention. Thus, pending independent Claim 1 complies with the

requirements of the first paragraph of 35 U.S.C. §112 and the rejection of Claim 1 is improper.

- (B) In Grounds of Rejection (B), the written description rejection of Claim 8 is improper because the limitations of Claim 8 which the Examiner alleges were not described in the original specification were described as noted below.**

For the same reasons given above with regard to Grounds of Rejection (B), pending independent Claim 8 complies with the requirements of 35 U.S.C. §112, first paragraph and, therefore, the rejection is improper.

- (C) In Grounds of Rejection (C), the written description rejection of Claim 15 is improper because the limitations of Claim 15 which the Examiner alleges were not described in the original specification were described as noted below.**

For the same reasons given above with regard to Grounds of Rejection (B), pending independent Claim 15 complies with the requirements of 35 U.S.C. §112, first paragraph and, therefore, the rejection is improper.

- (D) In Grounds of Rejection (D), the written description rejections of Claims 2-7, 9-14, and 16-21 are improper.**

Claims 2-7

Claims 2-7 comply with the requirements of 35 U.S.C. §112, first paragraph, as applied by the Office Action, at least, by their dependence on pending independent Claim 1.

Claims 9-14

Claims 9-14 comply with the requirements of 35 U.S.C. §112, first paragraph, as applied by the Office Action, at least, by their dependence on pending independent Claim 8.

Claims 16-21

Claims 16-21 comply with the requirements of 35 U.S.C. §112, first paragraph, as applied by the Office Action, at least, by their dependence on pending independent Claim 15.

(E) In Grounds of Rejection (E), the indefiniteness rejection of Claim 1 is improper.

At Item 3 at the bottom of page 4 in the Office Action, the Examiner alleges that it is unclear what is the first caller and what is the second caller. As noted above in section (A), Fig. 1 of the original specification, and heading v) above, telephone station 110 and computer system 130 belong to the claimed first caller and computer system 150 belongs to the claimed second caller. A first call is placed from the first caller's telephone station 110 to an address interceptor 140 and the second caller's computer system 150 where address interceptor 140 extracts a destination address of the first caller's computer system 130 from calling number identification signals sent with the first call. Then, a network call initiator of the second caller's computer system 150 employs the destination address of the first caller's computer system to automatically initiate a subsequent call from the second caller's computer system 150 to first caller's computer system 130 over computer network 160.

The second paragraph of 35 U.S.C. §112 states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

It is clear, as established above, that the claimed first caller uses the telephone station 110 to place the first call to the second caller's computer system 150) and the second caller uses the computer system 150 (to automatically initiate a subsequent call back to the first caller's computer system 110 over computer network 160). As such, pending independent Claim 1 complies with the

requirements of the second paragraph of 35 U.S.C. §112 and is definite. Therefore, the rejection of Claim 1 is improper.

(F) In Grounds of Rejection (F), the indefiniteness rejection of Claim 8 is improper.

For at least the same reasons given in Grounds of Rejection (E) above, pending independent Claim 8 is definite. Thus, pending independent Claim 8 complies with the requirements of 35 U.S.C. §112, second paragraph and, therefore, the rejection is improper.

(G) In Grounds of Rejection (G), the obviousness rejection of Claim 1 is improper because it relies on Scott to teach features which are not taught in the cited portions of Scott.

At item 5 at the middle of page 5 of the Office Action, the Examiner relies on Scott to teach automatically initiating (at page 5 of the Office Action) a subsequent telephone call (at page 6 of the Office Action). The cited portions of Scott relied upon by the Examiner disclose a gateway server 210 used to interface between public switched telephone network (PSTN) 205 and an Internet Protocol (IP) network 215. Services are provided by the gateway server 210, *e.g.*: properly route calls over IP network 215 (*see, e.g.*, line 60 of column 8 through line 12 of column 9 of Scott); select a service to handle an incoming call (*see, e.g.*, lines 60-65 of column 59 of Scott); assign users to a line group (*see, e.g.*, lines 17-19 of column 61 of Scott); use a privilege level to restrict routes (*see, e.g.*, lines 25-40 of column 61 of Scott); treat DNIS/DID information as the number the user wants to call (*see, e.g.*, lines 40-55 of column 61 of Scott); and translate digits entered by the user into E.164 form with an E.164 parser (*see, e.g.*, lines 15-35 of column 70 of Scott). As such, this portion of Scott teaches a first call from a first caller of a public switched telephone network to a second caller of an Internet Protocol network.

Claim 1 (and Claims 8 and 15) recite “A system for automatically initiating a subsequent telephone call over a computer network from a second caller to a first caller” (emphasis added.) As noted above, the invention as presently claimed teaches a first caller, using a telephone station 110, calls a second caller’s computer system 150 over PSTN 120 with a first call and then the second caller’s computer system 150 automatically initiates a subsequent call back to the first caller’s computer system 130 over computer network 160 using a destination address extracted by address interceptor 140. Thus, while the cited portions of Scott relied upon by the Examiner *may* teach the claimed first call from a first caller to a second caller, the cited portions of Scott do NOT teach initiating a subsequent telephone call from the second caller back to the first caller via a computer network as presently claimed.

As such, the cited portions of Scott do not teach or suggest each and every element of pending independent Claim 1. Williams has not been cited to cure this deficiency of Scott. For at least these reasons, the cited portions of the cited combination of Scott and Williams, as applied by the Examiner, do not provide a *prima facie* case of obviousness for pending independent Claim 1 and, therefore, the obviousness rejection is improper.

(H) In Grounds of Rejection (H), the obviousness rejection of Claim 8 is improper because it relies on Scott to teach features which are not taught in the cited portions of Scott.

For at least the same reasons given above in Grounds of Rejection (G), the cited portions of the cited combination of Scott and Williams, as applied by the Examiner do not provide a *prima facie* case of obviousness for pending independent Claim 8 and, therefore, the obviousness rejection is improper.

- (I) In Grounds of Rejection (I), the obviousness rejection of Claim 15 is improper because it relies on Scott to teach features which are not taught in the cited portions of Scott.**

For at least the same reasons given above in Grounds of Rejection (G), the cited portions of the cited combination of Scott and Williams, as applied by the Examiner do not provide a *prima facie* case of obviousness for pending independent Claim 15 and, therefore, the obviousness rejection is improper.

- (J) In Grounds of Rejection (J), the obviousness rejections of Claims 2-7, 9-14, and 16-21 are improper.**

Claims 2-7

Claims 2-7 are non-obvious over the combination of Scott and Williams, as applied by the Office Action, at least, by their dependence on pending independent Claim 1. *See* Grounds of Rejection (G).

Claims 9-14

Claims 9-14 are non-obvious over the combination of Scott and Williams, as applied by the Office Action, at least, by their dependence on pending independent Claim 8. *See* Grounds of Rejection (H).

Claims 16-21

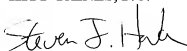
Claims 16-21 are non-obvious over the combination of Scott and Williams, as applied by the Office Action, at least, by their dependence on pending independent Claim 15. *See* Grounds of Rejection (I).

CONCLUSIONS

For the reasons set forth above, the Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's Rejection of all of the Appellant's pending claims and allow issuance thereof.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in black ink, appearing to read "Steven J. Hanke".

Steven J. Hanke
Registration No. 58,076

Dated: January 18, 2011
Hitt Gaines, PC
P. O. Box 832570
Richardson, Texas 75083-2570
(972) 480-8800
(972) 480-8865 (Fax)
steve.hanke@hittgaines.com

viii) APPENDIX A – CLAIMS

1. (Previously Presented) A system for automatically initiating a subsequent telephone call over a computer network from a second caller to a first caller, comprising:

an address interceptor, associated with a station of a circuit-switched telephone network, that receives calling number identification signals of said first caller from a first telephone call from said first caller to said second caller over said circuit-switched telephone network and extracts from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller; and

a network call initiator, coupled to said address interceptor and associated with a computer network terminal, that employs said destination address of said first caller to automatically initiate said subsequent telephone call to said destination address via said computer network terminal.

2. (Original) The system as recited in Claim 1 wherein said calling number identification signals and said destination address are associated with a single location.

3. (Original) The system as recited in Claim 1 wherein said destination address is selected from the group consisting of:

a telephone number,

an Internet Protocol address,

a Voice over Internet Protocol (VoIP) gateway address, and

a VoIP gateway address combined with a telephone number.

4. (Original) The system as recited in Claim 1 wherein said computer network is the Internet.

5. (Original) The system as recited in Claim 1 wherein said station leaves unanswered a call transmitting said calling number identification signals.

6. (Original) The system as recited in Claim 1 wherein said calling number identification signals are associated with a second station, said second station hanging up after a predetermined number of unanswered rings.

7. (Original) The system as recited in Claim 1 wherein said station and said computer network terminal are embodied in a computer and wherein a single telephone line alternatively couples said station to said circuit-switched telephone network and said computer network terminal to said computer network.

8. (Previously Presented) A method of automatically initiating a subsequent telephone call over a computer network from a second caller to a first caller, comprising:

extracting a destination address for said subsequent telephone call from calling number identification signals received from a first telephone call over a circuit-switched telephone network from said first caller to said second caller; and

employing said destination address of said first caller to automatically initiate said subsequent telephone call to said destination address via said computer network.

9. (Original) The method as recited in Claim 8 wherein said calling number identification signals and said destination address are associated with a single location.

10. (Original) The method as recited in Claim 8 wherein said destination address is selected from the group consisting of:

a telephone number,
an Internet Protocol address,
a Voice over Internet Protocol (VoIP) gateway address, and
a VoIP gateway address combined with a telephone number.

11. (Original) The method as recited in Claim 8 wherein said computer network is the Internet.

12. (Original) The method as recited in Claim 8 further comprising leaving unanswered a call transmitting said calling number identification signals.

13. (Original) The method as recited in Claim 8 wherein said calling number identification signals are associated with a station, said method further comprising hanging up said station after a predetermined number of unanswered rings.

14. (Original) The method as recited in Claim 8 wherein said method is carried out in a computer and wherein a single telephone line alternatively carries said calling number identification signals and said destination address.

15. (Previously Presented) A computer, comprising:

a processor;

a memory coupled to said processor;

a display coupled to said processor;

at least one input device coupled to said processor;

a circuit-switched telephone network interface, coupled to said processor, for receiving a first

telephone call from a first caller over a circuit-switched telephone network couplable thereto, said first telephone call including calling number identification signals;

a computer network interface, coupled to said processor, for allowing said computer to communicate over a computer network;

an address interceptor, coupled to said processor and communicable with said circuit-switched telephone network interface, for extracting a destination address of said first caller for a subsequent telephone call to said first caller from said calling number identification signals; and

a network call initiator, coupled to said processor, for employing said destination address of said first caller to automatically initiate said subsequent telephone call to said destination address of said first caller via said computer network interface.

16. (Original) The computer as recited in Claim 15 wherein said calling number identification signals and said destination address are associated with a single location.

17. (Original) The computer as recited in Claim 15 wherein said destination address is selected from the group consisting of:

a telephone number,

an Internet Protocol address,

a Voice over Internet Protocol (VoIP) gateway address, and

a VoIP gateway address combined with a telephone number.

18. (Original) The computer as recited in Claim 15 wherein said computer network is the Internet.

19. (Original) The computer as recited in Claim 15 wherein said circuit-switched telephone

network interface leaves said call unanswered.

20. (Original) The computer as recited in Claim 15 wherein a station placing said call hangs up after a predetermined number of unanswered rings.

21. (Original) The computer as recited in Claim 15 wherein said circuit-switched telephone network interface and said computer network interface are coupled to a single telephone line.

ix) APPENDIX B – EVIDENCE

The evidence in this appendix includes U.S. Patents to Scott, *et al.*, and Hon. Scott was entered in the record by the Examiner in the Office Action of April 28, 2005. Hon was entered in the record by the Examiner in Office Action of January 22, 2010.

x) RELATED PROCEEDINGS APPENDIX

NONE